



**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE EXAMINING GROUP 3711**

Attorney's Docket No: 9052-74

PATENT

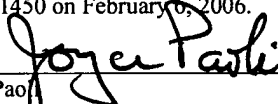
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Derek Priestley, et al.
Serial No.: 09/922,823
Filed: August 6, 2001
For: COLOUR MATCHING SYSTEM

Confirmation No. 8860
Group No.: 3732
Examiner: Ralph A. Lewis

February 6, 2006

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Joyce Paoli

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

A Petition for an Extension of Time is submitted herewith. If any further fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 09-0461.

REMARKS

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed July 5, 2005 (the Action). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Applicants believe that the rejections in the Action include clear errors as required by the rules connected with the Pre-Appeal Brief Conference.

I. Status of the Claims

Claims 1-17, 20-28, 30-32, 34-37, 39-41, 43, 44, 46-51, 53, 54 and 57 are pending. Claims 12-17, 43 and 57 are allowed. Claims 1-3, 7, 22, 23, 26-28, 30, 31, 34, 37, 39, 40, 44, 50, 51 and 53 stand rejected under Section 102(e) based on U.S. Patent No. 6,328,567 to Morris et al (Morris). Claims 1-3, 5-7, 20-24, 26-28, 30, 31, 34-37, 39, 40, 41, 44, 46-51, 53 and 54 stand rejected under Section 103(a) based on Morris. Claims 4, 25 and 32 stand rejected under Section 103(a) based on Morris in view of U.S. Patent No. 5,967,775 to Shahid et al (Shahid). Claims 7-11 stand rejected under Section 103(a) based on Morris in view of U.S. Patent No. 6,206,691 to Lehmann et al. (Lehmann). These rejections are addressed below.

II. Section 102(e) Rejections

The Action states that Morris anticipates Claims 1-3, 7, 22, 23, 26-28, 30, 31, 34, 37, 39, 40, 44, 50, 51 and 53. The Action characterizes Morris as disclosing:

a system comprising a digital camera for taking colored images, means for relaying the images, means for analyzing the color values of the images, and means for converting the color values into parameters from which the original color may be reconstituted.

The Action at page 2 (citations omitted). The Action then states:

[i]n regard to the "single gray reference" limitation, Morris et al discloses the use of a single "A1" dental shade tab 109 which is later described as "a light tan color." First in regard to the "single" limitation, it is noted that the applicant uses the open term "comprising" in the claims which indicates that the system may include other elements other than those listed (e.g. black and white indicators). Applicant does not address this issue in his remarks.

Id. at pages 2-3 (citations omitted).

In response, Applicants disagree with the finding in the Action that the term "single grey reference" somehow encompasses the possibility of including other color indicators (such as black or white indicators, as the Action suggests), simply because the overall transitional term of the claim is "comprising." Applicants have stated on the record (*see* Applicant's paper dated November 4, 2005) that the intention of the claim language is to convey to those of skill in this art that the system recited in the claim includes only one reference color indicator, and that the sole reference color indicator is a grey reference color indicator. The claims at issue are not intended to encompass (and, Applicants submit, do not encompass) systems with additional reference color indicators, as suggested in the Action, due to the use of the transitional term "comprising." Applicants submit that the term "comprising" indicates that other components may be present in the system, but that the term "single grey reference color indicator" requires that only one color indicator, which is grey, be present.

It is clear from the Action that the Morris system employs multiple reference color indicators. As such, it does not employ a "single grey reference color indicator" as recited in Claims 1, 28, 30 and 44 and, therefore, cannot anticipate any of these claims or claims depending therefrom. Accordingly, Applicants respectfully submit that the rejections under Section 102(e) are clearly erroneous.

III. Rejections under Section 103(a)

In rejecting Claims 1-3, 5-7, 20-24, 26-28, 30, 31, 34-37, 39, 40, 41, 44, 46-51, 53 and 54 under Section 103(a) based on Morris, the Action states:

[i]n regard to the present rejection applicant argues that his system uses only a single color reference whereas the Morris et al system uses three reference colors. It is noted that applicant's arguments are narrower than the claims. The claims use the open term "comprising" which indicates that other elements may be present in the claimed invention including other reference colors.


Id. at page 4.

In response, Applicants respectfully point to Section II above, wherein Applicants have addressed this issue: namely, that the claims are intended to cover systems that employ only a single reference color indicator, that the single reference color indicator is grey, and that the claim language is consistent with this intention. As such, Applicants respectfully submit that Morris fails to suggest in any manner a system that employs only a single grey reference color indicator. Applicants also submit that the secondary references of record (Shahid and Lehmann) also fail to disclose or suggest such a system. As such, Applicants respectfully submit that it would not have been obvious to the ordinarily skilled artisan to conceive the recited system based on the cited references, and respectfully request that the rejections under Section 103(a) are clearly erroneous.

III. Conclusion

In view of the foregoing, Applicant respectfully submits that the rejections set forth in the Action are clearly erroneous. Therefore, Applicant respectfully requests that the rejections of the present application be reviewed and reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



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